

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed December 21, 2005 and subsequent Advisory Action mailed March 14, 2006. Upon entry of the amendments in this response, claims 1, 3, 4, 6 – 21 and 28 - 31 remain pending. In particular, Applicant has added new claim 31 and has canceled claims 22 - 27 without prejudice, waiver, or disclaimer. Applicant has canceled claims 22 - 27 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Rejections Under 35 U.S.C. §101**

The Office Action indicates that claims 22 – 26 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In this regard, Applicants previously amended claim 22 to recite a “tangible” computer readable medium, which should have alleviated the rejection. Clearly, the direct antecedent basis for claim language is not a requirement of the Patent Laws as appears to be indicated in the Advisory Action. Regardless, Applicants have canceled claims 22 – 26 thereby rendering the rejection moot.

### **Rejections Under 35 U.S.C. §112, First Paragraph**

The Office Action indicates that claim 22 is rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. However, Applicants have canceled claim 22 thereby rendering the rejection moot.

### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 1 – 6, 10 – 13, 15 – 16, 19 – 20, 22 – 23 and 26 - 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Baker* in view of *Krueger*. The Office Action further indicates that claims 7 – 9, 17 – 18 and 24 - 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Baker* in view of *Krueger* in view of *Naylor*. The Office Action further indicates that claims 14 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Baker* in view of *Krueger* in view of *Nielsen*. As set forth above, Applicants have canceled claims 22 – 26, and respectfully assert that the rejection as to these claims has been rendered moot. Applicants respectfully traverse the rejections.

In this regard, Applicants respectfully agree with the contention in the Office Action indicating that *Baker* does not teach automatic sending of a revised document. Additionally, since *Baker* does not involve such sending, *Baker* also does not teach or reasonably suggest appending of information corresponding to an email address to the document that was sent via email.

However, the Office Action indicates that *Baker* teaches “encoding the document with information” and refers Applicants to columns 1 and 2. In this regard, it appears that the Office Action is improperly attributing the encoding of an email header to the encoding of a document. That is, in contrast to Applicants’ recitation of encoding the document (which was sent as an attachment), *Baker* involves encoding an email in a conventional manner. *Baker* is not involved in any manner with encoding a document that was attached to an email. This is in direct contrast to the limitations recited in Applicants’ claims.

*Krueger* does not remedy this deficiency of *Baker*. That is, *Krueger* involves compiling a database of email addresses and sending revisions to a document to the email addresses of the database. However, and similar to that of *Baker*, *Krueger* does not teach or

reasonably suggest appending such information to the document that was sent via email. In this regard, Applicants respectfully assert that Applicants' use of antecedent basis, such as with respect to the term "document," may not have been fully considered.

With respect to claim 1, that claim recites:

1. A method for sending documents, comprising:  
determining whether a user sent a copy of *a document*, created by an application other than an email application, *as an email attachment to a first set of at least one recipient via email*; and  
if the user sent the copy of the document to the at least one recipient of the first set as an email attachment using an email application, *correlating information with the document so that a copy of a revised version of the document can be sent automatically as another email attachment to the at least one recipient of the first set without the user accessing the email application*;  
*wherein correlating comprises encoding the document with the information, and the information comprises an email address of the at least one recipient of the first set to which the email attachment was sent via email.*

(Emphasis added).

Applicants respectfully assert that the references are legally deficient for the purpose of rendering claim 1 unpatentable. In particular, Applicants respectfully assert that the cited references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 1. In this regard, neither involves "encoding the document with the information" as recited in claim 1. Therefore, Applicants respectfully assert that claim 1 is in condition for allowance.

With respect to claim 15, claim recites:

15. A communications system, comprising:  
a document-sending system configured to:  
determine whether a user sent a copy of *a document created by an application other than an email application and attached to an email message to a first set of at least one recipient via email*; and  
*encode the document with information comprising an email address to which the document was sent via email* so that a copy of a revised version of the document can be sent automatically to the email address as an attachment to another email message without the user accessing the email application, if the user sent the copy of the

document to the at least one recipient of the first set as an email attachment using an email application.

(Emphasis added).

Applicants respectfully assert that the references are legally deficient for the purpose of rendering claim 15 unpatentable. In particular, Applicants respectfully assert that the cited references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 15. In this regard, neither involves to “encode the document with information comprising an email address to which the document was sent via email” as recited in claim 15. Therefore, Applicants respectfully assert that claim 15 is in condition for allowance.

With respect to claim 28, that claim recites:

28. A method for sending information via email, comprising:  
*creating a file* using an application other than an email application;  
*attaching the file to an email message* as a first email attachment;  
designating a first recipient to receive the email message with the first email attachment; and  
*encoding the file with information corresponding to an email address to which the email message was sent via email* so that a revised version of the file is automatically sent to the first recipient, at the email address encoded with the file, as a second email attachment via a subsequent email in response to the file being revised using the application.

(Emphasis added).

Applicants respectfully assert that the references are legally deficient for the purpose of rendering claim 28 unpatentable. In particular, Applicants respectfully assert that the cited references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 28. In this regard, neither involves “encoding the file with information corresponding to an email address to which the email message was sent via email” as recited in claim 28. Therefore, Applicants respectfully assert that claim 28 is in condition for allowance.

With respect to the rejection of dependent claims 3, 4, 6 – 14, 16 – 21, 29 and 30, Applicants respectfully assert that none of the references or combinations thereof, teaches or

reasonably suggests at least the features/limitations emphasized above in independent claims 1, 15, 22 and 28. That is, neither *Naylor* nor *Nielsen* teaches or reasonably suggests at least the features/limitations emphasized above in independent claims 1, 15, 22 and 28 that are lacking in *Baker* and *Krueger*. Therefore, Applicants respectfully assert that the aforementioned dependent claims are in condition for allowance because they incorporate all the features/limitations of their respective independent claims. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

### **Newly Added Claim**

In this response, Applicants have added new claim 31 and respectfully assert that no new matter has been added. In particular, claim 31 recites:

31. A computer-readable medium configured as an electromagnetic device and storing a computer program for sending documents, the computer program being operative to perform the computer-implemented method comprising:

determining whether a user sent a copy of a document created by an application other than an email application and attached to an email message to a first set of at least one recipient via email; and  
appending information, comprising an email address to which the document was set via email, to the document so that a copy of a revised version of the document can be sent automatically to the email address without the user accessing the email application;  
determining that a revised version of the document has been created; and  
responsive to determining that the revised version of the document has been created, automatically sending a copy of the revised version of the document to the at least one recipient of the first set as an email attachment using an email application by accessing the information appended to the document.

(Emphasis added).

Applicants respectfully assert that the references are legally deficient for the purpose of rendering claim 31 unpatentable. In particular, Applicants respectfully assert that the cited references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 31. In this regard, neither involves

“appending information. . .to the document” as recited in claim 31. Therefore, Applicants respectfully assert that claim 31 is in condition for allowance.

**Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

## **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 4/21/06.

Stephanie Riley  
Signature